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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/756,970	01/13/2004	Kevin T. Foley	MSDI-223/PC-444.06	3770
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MEDTRONIC				
Attn: Noreen Johnson - IP Legal Department				
2600 Sofamor Danck Drive				
MEMPHIS, TN 38132				
EXAMINER				
HOFFMAN, MARY C				
ART UNIT		PAPER NUMBER		
3733				
MAIL DATE		DELIVERY MODE		
08/19/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary**Application No.**

10/756,970

Applicant(s)

FOLEY ET AL.

Examiner

MARY HOFFMAN

Art Unit

3733

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 June 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 55-63, 65-74 and 94-103 is/are pending in the application.
- 4a) Of the above claim(s) 71-73 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 55-63, 65-70 and 94-103 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

The finality of the office action mailed 12/26/2008 is withdrawn.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

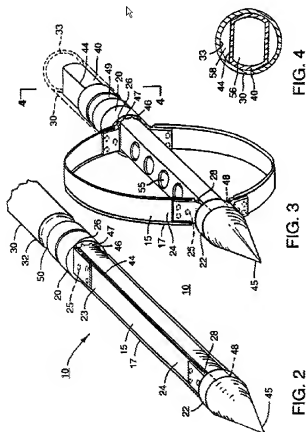
A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 55-63, 65 and 74 are rejected under 35 U.S.C. 102(b) as being anticipated by Kieturakis (US 5,794,626).

Kieturakis discloses an elongate member (FIG. 1) extending along a longitudinal axis and including a deformable distal portion (ref. #15) having an initial configuration and an expanded configuration wherein the deformable distal portion is outwardly deformed to define no more than two transverse projections. Each of the transverse projections arranged along a single transverse axis, and wherein formation of the transverse projections is directionally controlled such that each of the transverse projections extends in a uni-axial direction aligned with the single transverse axis. The elongate member comprises an inner actuator member disposed within an outer sleeve member, a distal portion of the sleeve member being outwardly deformed to define the transverse projections in response to relative displacement between the actuator member (ref. #44) and the sleeve member (ref. #33); and wherein the deformable distal

portion comprises at least one flexible strip of material (ref. #15) having a length extending along the longitudinal axis, the flexible strip of material having an outwardly buckled configuration defining one of the transverse projections, the flexible strip of material configured such that the relative displacement between the actuator member and the sleeve member transitions the flexible strip of material to the outwardly buckled configuration and provides the one of the transverse projections with an arc-shaped outer curvature extending along the length of the flexible strip of material and configured to bear against vertebral bone.



The displacement of the at least a portion of the spinal structure is directionally controlled.

The displacement of the at least a portion of the spinal structure is unidirectional.

The outward deformation of the transverse projections is selectively controlled to generate a controlled magnitude of force.

The expanded configuration defines a single pair of transverse projections arranged generally opposite one another along the single transverse axis.

The relative displacement between the actuator member and the sleeve member is relative linear displacement.

The deformable distal portion is at least partially formed of a shape-memory material, the deformable distal portion being reformed from the initial configuration toward the expanded configuration in response to the imposition of stress and automatically reformed back toward the initial configuration upon removal of the stress.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 66-70 and 94-103 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kieturakis (US 5,794,626) in view of Augros (US 4,338,952).

Kieturakis discloses the claimed invention except for the longitudinally extending slots between the strips having narrowed and widened areas to provide the flexible strip

of material with a narrowed width which defines a flexion point to control outward deformation of the flexible strip of material to the outwardly buckled configuration, and the widened and narrowed areas making the slots into an hour-glass shape.

Augros discloses flexible cutting strips/blades that have a hinge (ref. #3a) to better control the shape and angle of deformation of the cutting strips/blades. Incorporating this type of hinge into Kieturakis would result in the longitudinally extending slots between the strips to have narrowed and widened areas to provide the flexible strip of material with a narrowed width which defines a flexion point to control outward deformation of the flexible strip of material to the outwardly buckled configuration, and the widened and narrowed areas making the slots into a partially hour-glass shape.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to construct the device of Kieturakis with the longitudinally extending slots between the strips having narrowed and widened areas to provide the flexible strip of material with a narrowed width which defines a flexion point to control outward deformation of the flexible strip of material to the outwardly buckled configuration, and the widened and narrowed areas making the slots into an hour-glass shape. in view of Augros to better control the shape and angle of deformation of the cutting strips/blades.

Response to Arguments

Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment filed 09/05/2008 necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **MARY HOFFMAN** whose telephone number is (571)272-5566. The examiner can normally be reached on Monday-Thursday 10:00-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo C. Robert can be reached on 571-272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Mary C. Hoffman/
Examiner, Art Unit 3733

/Corrine M McDermott/
Supervisory Patent Examiner, Art Unit 3738